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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,914	07/03/2003	Jerome P. Horwitz	1319.007US1	4646
21186	7590	10/28/2005	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH 1600 TCF TOWER 121 SOUTH EIGHT STREET MINNEAPOLIS, MN 55402			QAZI, SABIHA NAIM	
		ART UNIT	PAPER NUMBER	
		1616		

DATE MAILED: 10/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/613,914	HORWITZ ET AL.	
	Examiner	Art Unit	
	Sabiha Qazi	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 August 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-30,49-58 and 61-64 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 1-30 and 49-54 is/are allowed.
- 6) Claim(s) 55-58 and 61-64 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8-4-05</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

Non-Final Office Action

Acknowledgement is made of the response filed on 08/04/05. Amendments are entered. Claims 1-30, 49-58 and 61-64 are pending. Claims 1-30 and 49-54 are allowed. Claims 55-58 and 61-64 are rejected. Rejection under 112 (2) and under 101 is withdrawn because claims are amended. Applicant's affirmation of election is acknowledged. The restriction is made Final.

Applicant's arguments regarding 112 (1st para) rejection have been fully considered but are not found persuasive therefore, rejection is maintained for the same reasons as set forth in our previous office action.

Claim Rejections - 35 USC § 112 – Second Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 54-58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Following reasons apply:

Claims 54-58 are improperly dependent on cancelled claims 31-48. A correction is requested.

Claims Claim Rejections - 35 USC § 112 – First Paragraph Rejection

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to

enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 61-64 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the specific cancers tested against in the specification, does not reasonable provide enablement for the treatment of all cancers.

The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

Factors to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. 112, first paragraph, have been described in In re Colianni, 195 USPQ 150, 153 (CCPA 1977), have been clarified by the Board of Patent Appeals and Interferences in Ex parte Forman, 230 USPQ 546 (BPAI 1986), and are summarized in In re Wands (858 F2d 731, 737, 8 USPQ2d 1400, 1404 (Fed Cir. 1988)). Among these factors are: (1) the nature of the invention; (2) the state of the prior art; (3) the relative skill of those in the art; (4) the predictability or unpredictability of the art; (5) the breadth of the claims; (6) the amount of direction or guidance presented; (7) the presence or absence of working examples; and (8) the quantity of experimentation necessary.

When the above factors are weighed, it is the examiner's position that one skilled in the art could not practice the invention without undue experimentation.

(1) The nature of the invention: The claims are drawn to a therapeutic method to treat

cancer in a mammal.

(2) The predictability or unpredictability of the art: There is lack of predictability in the in the pharmaceutical art especially in the methods for treatment of cancer.

Evidence involving a single compound and two types of cancer was not found sufficient to establish the enablement of claims directed to a method of treating seven types of cancer with members of a class of several compounds. *In re Buting*, 163 USPQ 689. The disclosure provides no indication of whether the compounds treat all cancers. To make clearer the lack of enablement for treatment of all cancer, extrinsic evidence is supplied by Draetta (*Ann. Reports Med. Chem.*), Draetta et al. in "Annual Reports in Medicinal Chemistry", 1996, Academic Press, San Diego, pp 241-246, final sentence on page 246 although many still think about the need for a magic bullet as a cure for all cancers, our knowledge of the molecular mechanism underlying this disease make the prospect of developing such a universal cure very unlikely." Since no universal cure for cancer has been developed, it follows that there is no correlation between the assays relied upon by applicants and the ability to treat all cancers. Thus, those assays are not sufficient to enable such claims.

Further, in the art of clinical oncology, no compound has yet shown clinical efficacy against every type of cancer. Different agents are used for different forms of cancer and no single agent is listed as a treatment of every single type of cancer. Balasubramanian reference (Recent Developments in Cancer Cytotoxics) on page 151 first paragraph "the successful treatment of solid tumors remains a formidable challenge."

Applicant has provided no evidence, which incontrovertibly demonstrates that the tests set forth in the instant specification are art-recognized, reliable predictors of successful treatable, *in vivo*, of all cancers. The worker of ordinary skill in the art would not be able to practice the instantly claimed method, since no description is found of an actual method wherein a cancer in a host is treated. Applicants fail to fulfill the requirement of 35 U.S.C. 112, first paragraph, by failing to provide an adequate written description of how to treat all cancers in a single host.

(3) The amount of direction or guidance presented: There is no guidance in the disclosure on how to use the invention successfully for treating any cancer as claimed.

In re Dreshfield, 110 F.2d 235, 45 USPQ 36 (CCPA 1940), gives this general rule: "It is well settled that in cases involving chemicals and chemical compounds, which differ radically in their properties it must appear in an applicant's specification either by the enumeration of a sufficient number of the members of a group or by other appropriate language, that the chemicals or chemical combinations included in the claims are capable of accomplishing the desired result."

The courts have further interpreted undue experimentation as requiring "ingenuity beyond that to be expected of one of ordinary skill in the art" (Fields v. Conover, 170 USPQ 276 (CCPA 1971)) or requiring an extended period of experimentation in the absence of sufficient direction or guidance (In re Colianni, 195 USPQ 150 (CCPA 1977)). Additionally, the courts have determined that "... where a statement is, on its face, contrary to generally accepted scientific principles", a rejection for failure to teach how to make and/or use is proper (In re Marzocchi, 169 USPQ 367 (CCPA 1971)).

(4) The presence or absence of working examples: A disclosure should contain representative examples, which provide reasonable assurance to one skilled in the art that the compounds fall within the scope of a claim will possess the alleged activity. See *In re Riat et al.* (CCPA 1964) 327 F2d 685, 140 USPQ 471; *In re Barr et al.* (CCPA 1971) 444 F 2d 349, 151 USPQ 724.

(5) The quantity of experimentation necessary: Since there is no guidance presented in the disclosure, how to treat “cancer” successfully by claimed compounds, one skilled in the art at the time of invention would have to go through undue experimentation to make and/or use the presently claimed invention.

Allowable Subject Matter

1. Claims 1-30 and 49-54 are allowed. Prior art of record does not teach nor fairly suggests the compounds of formula (I) when A represents C atom.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha Qazi whose telephone number is (571) 272-0622. The examiner can normally be reached on any business day.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on (571) 272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1616

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SABIHA QAZI, PH.D
PRIMARY EXAMINER

Tuesday, October 25, 2005